

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Shuwu Wu et al.	Art Unit	: 2155
Serial No.	: 09/810,159	Examiner	: Asad M. Nawaz
Filed	: March 19, 2001	Conf. No.	: 9046
Title	: VOICE INSTANT MESSAGING		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In communications dated May 18, 2007, the Patent Office indicated that the appeal brief filed on January 10, 2007 did not comply with 37 CFR 41.37 and 37 CFR 1.121. In particular, the Patent Office indicated that Appendix of Claims did not include all claims involved in the appeal process because claims 27-36, which were previously withdrawn, were not included. Appellants have amended the Appendix of Claims to include the withdrawn claims. Accordingly, appellants submit that the appeal brief should now comply with 37 CFR 41.37 and 37 CFR 1.121.

BRIEF ON APPEAL

(1) Real Party in Interest

America Online, Inc., the assignee of this application, is the real party in interest.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 1-25, 37-39 and 41-44 are pending, with claims 1, 21, 22 and 44 being independent. Claims 27-36 were previously withdrawn. Claims 1-25, 37-39 and 41-44 stand rejected. Appellants appeal the rejections of claims 1-25, 37-39 and 41-44.

(4) Status of Amendments

An amendment was filed on September 15, 2005 in response to a non-final Office Action mailed on June 15, 2005. The amendment was entered by the Examiner. Two final Office Actions were subsequently received – the first on December 2, 2005 and the second on April 19, 2006. Responses to these final Office Actions without amendment were filed on March 2, 2006 and June 19, 2006, respectively. An advisory action was mailed on August 7, 2006. A Notice of Appeal was filed on October 10, 2006.

(5) Summary of Claimed Subject Matter

The currently pending claims relate to a text instant messaging system that further enables users to establish voice communications with each other. The following summarizes independent claims 1, 21, 22 and 44.

Independent claim 1 is directed to a communications method that includes establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host, such as, for example, between the sender 602a and the recipient 602b through the host 604 of Fig. 6. See Fig. 6; page 15, line 23 to page 16, line 24. A text instant message is facilitated to be sent from the sender 602a to the recipient 602b during the session. See Fig. 6, steps 605-640, and page 17, line 17 to page 18, line 16. The text instant message includes message text inputted by the sender 602a. A presentation of a first text instant messaging user interface, such as, for example, a START TALK UI 700, that includes a display of the message text and an icon, such as, for example, message text “HELLO TALKSTR1!” and a START TALK button 710, is enabled to be presented to the recipient 602b conditioned on communication of the text instant message between the sender 602a and the recipient 602b. See Fig 6, steps 630-640; page 18, lines 9-16; Fig. 7; page 21, lines 25-27. Manipulation by the recipient 602b of the START TALK button 710 is enabled to invoke voice communication between the sender 602a and the recipient 602b through the host 604. See Fig. 6, steps 645-670; page 18, line 17 to page 19, line 10.

Independent claim 21 is directed to an apparatus comprising an instant messaging host, such as, for example, host 604 of Fig. 6. The host 604 is configured to establish a text instant messaging communication session between a sender and a recipient, such as, for example, between the sender 602a and the recipient 602b of Fig. 6. See Fig. 6; page 15, line 23 to page 16, line 24. The host 604 is configured to facilitate a text instant message to be sent from the

sender 602a to the recipient 602b during the session. See Fig. 6, steps 605-640, and page 17, line 17 to page 18, line 16. The text instant message includes message text inputted by the sender 602a. The host 604 is configured to enable presentation of a first text instant messaging user interface, such as, for example, a START TALK UI 700, that includes a display of message text and an icon, such as, for example, message text "HELLO TALKSTR1!" and a START TALK button 710, to the recipient 602b conditioned on communication of the text instant message between the sender 602a and the recipient 602b. See Fig 6, steps 630-640; page 18, lines 9-16; Fig. 7; page 21, lines 25-27. The host 604 is configured to enable manipulation by the recipient 602b of the START TALK button 710 to invoke voice communication between the sender 602a and the recipient 602b. See Fig. 6, steps 645-670; page 18, line 17 to page 19, line 10.

Independent claim 22 is directed to a computer program stored in a tangible computer readable medium such as, for example, a host controller 140. See page 4, line 29 to page 5, line 5. The host controller 140 includes instructions for establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host, such as, for example, between the sender 602a and the recipient 602b through the host 604 of Fig. 6. See Fig. 6; page 15, line 23 to page 16, line 24. The host controller 140 includes instructions for facilitating a text instant message to be sent from the sender 602a to the recipient 602b during the session. See Fig. 6, steps 605-640, and page 17, line 17 to page 18, line 16. The text instant message includes message text inputted by the sender 602a. The host controller 140 includes instructions for enabling presentation of a first text instant messaging user interface, such as, for example, a START TALK UI 700, that includes a display of the message text and an icon, such as, for example, message text "HELLO TALKSTR1!" and a START TALK button 710, to the recipient 602b conditioned on communication of the text instant message between the sender 602a and the recipient 602b. See Fig 6, steps 630-640; page 18, lines 9-16; Fig. 7; page 21, lines 25-27. The host controller 140 includes instructions for enabling manipulation by the recipient 602b of the START TALK button 710 to invoke voice communication between the sender 602a and the recipient 602b through the host 604. See Fig. 6, steps 645-670; page 18, line 17 to page 19, line 10.

Independent claim 44 is directed to a communications method that includes receiving from a sender, such as, for example, sender 602a, a text instant message addressed to a recipient, such as, for example, recipient 602b. See Fig. 6, step 610; page 17, lines 19-21. The text instant

message includes message text inputted by the sender 602a. The capabilities of the recipient 602b are determined in response to receipt of the text instant message. See Fig. 6, step 615; page 17, line 27 to page 18, line 1. The text instant message is delivered to the recipient. See Fig. 6, step 630; page 18, line 9-10. A presentation of a first text instant messaging user interface, such as, for example, a START TALK UI 700, that includes a display of the message text and an icon, such as, for example, message text "HELLO TALKSTRI!" and a START TALK button 710, is enabled to be presented to the recipient 602b conditioned on whether the recipient 602b is determined to be capable of voice communications. See Fig 6, steps 630-640; page 18, lines 9-16; Fig. 7; page 21, lines 25-27. Manipulation by the recipient 602b of the START TALK button 710 is enabled to invoke voice communication between the sender 602a and the recipient 602b through the host 604. See Fig. 6, steps 645-670; page 18, line 17 to page 19, line 10.

(6) Grounds of Rejection to be Reviewed on Appeal

Independent claims 1, 21, 22 and 44, and their dependent claims 2-20, 23-25, 37-39 and 41-43, have been rejected as being unpatentable over Cook (U.S. Patent No. 6,879,665) in view of PowWow (NPL dated 3/1/2000).

(7) Argument

Appellants submit the following arguments in support of reversal of the rejection of the above-listed claims.

(a) The subject matter of independent claims 1, 21 and 22, along with their dependent claims 2-20, 23-25, 37-39, and 41-43, is not obvious in view of the teachings of Cook and PowWow

Independent claims 1, 21 and 22 each recite, among other features, "enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient" (emphasis added) and "enabling manipulation by the recipient of the icon to invoke voice communications". Appellants request reversal of the rejection of claims 1, 21 and 22, and their dependent claims, because neither Cook, PowWow, nor any proper combination of the two describes or suggests enabling presentation of the recited text instant

messaging graphical user interface (GUI) including a display of an icon and a message text of a text instant message, the icon being manipulable by the recipient of the text instant message to invoke voice communications, wherein the presentation of the GUI is conditioned on communication of the text instant message between the sender and the recipient.

Cook describes an e-mail system that has been modified to support the communication of voice messages. As stated in the response to the Final Office Action of December 2, 2005, Cook's system is substantially different from an instant messaging system. The Examiner acknowledges Cook's failure to teach instant messaging but refers to PowWow as rectifying this deficiency:

However, Cook does not explicitly indicate that the text message is an instant message. PowWow teaches a similar system as Cook that facilitates voice instant messages. Furthermore, a voice chat can be carried out in a plurality of ways. In all such cases, one must have a connection with a person. In one method, if a user is connected via instant messaging, an icon labeled the voice button can be activated and thus initiate a voice chat (see Method 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of PowWow into those of Cook to make the system versatile. In analogous art such as Cook, one would have a greater advantage in providing features such as voice messaging, integrated voice chat, instant messaging, and point to multi-point communications.

See Final Office Action, pages 3 and 4 (emphasis added).

PowWow teaches client software that supports "instant voice messaging and integrated voice chat capabilities" and "instant messaging, buddy lists, and real-time point-to-multi-point communications and telephony." See PowWow, page 1, lines 21-25 of the Dialog Global Reporter printout. As such, it is unclear how the Examiner is contending that the teachings of PowWow remedy the deficiency of Cook to describe or suggest instant messaging features.

If the Examiner is suggesting that PowWow's teachings would lead one of ordinary skill in the art to convert the e-mails and e-mail features (relied upon by the Examiner to reject various claims) in Cook's e-mail system into instant messages and instant messaging features, appellants respectfully disagree. PowWow teaches an entirely stand-alone instant messaging system that, aside from both dealing with electronic communications between users, has little to nothing to do with an e-mail system.

If the Examiner is suggesting that PowWow's teachings would somehow enable one of ordinary skill in the art in view of Cook to supplement the e-mail features of Cook's system with PowWow's instant messaging features "to make the system versatile." It is unclear how or in what fashion these two disparate systems could be combined into a new universal

communications system. Specifically, PowWow fails to disclose the concept of integrating its teachings into other communication systems or types, or otherwise applying them to other such systems or types. Absent such teachings, or any suggestion by either reference of the same, a contention that the two would be combinable in this manner is necessarily premised on impermissible hindsight, leading to an improper combination.

And, even if we assume (for the sake of argument) that a suggestion is made by either of Cook or PowWow for their integration, the combination fails to meet the claimed invention. Stated differently, even if Cook's e-mail system could somehow be properly modified to become an e-mail/instant messaging system that not only includes the e-mail functionality described by Cook but also includes the instant messaging functionality described by PowWow, this new system would still fail to meet the recited limitation of enabling presentation of a GUI that includes the recited icon and the recited instant message text of a text instant message, the presentation of the GUI being conditioned on communication of the text instant message between the sender and the recipient.

Specifically, PowWow teaches multiple methods of establishing a voice chat between users through use of a Personal Communicator window in a GUI of PowWow's client software. While PowWow describes a user selecting a Voice Button, which the Examiner equates to the recited icon, in the Personal Communicator window to invoke voice communications between the user and one or more other users, PowWow does not describe or suggest that the personal communicator window also displays instant message text of a text instant message and that presentation of the Personal Communicator window is conditioned on communication of the text instant message between the user and another user. Rather, PowWow is careful to teach that the Voice button is "displayed only when two or more people are connected through the Personal Communicator," providing no description or suggestion that the connection between the users and subsequent display of the voice button, much less the display of the Personal Communicator window, is conditioned on receipt or delivery of a text instant message by the user from/to another user. See page 2 of web printout of PowWow.

In the advisory action of August 7, 2006, the Examiner responded to these arguments by stating:

The applicant argues in substance that PowWow does not teach the Personal communicator window being conditioned on communication of the text instant message between the user and another user. In response, it is important to understand that PowWow has been used as a secondary reference to

teach the deficiency of Cook. Nevertheless, PowWow teaches that the voice instant message is started based on an existing communication between two Personal Communicator. This communication of text instant messaging must be present in order for voice instant messaging to commence (See PowWow Voice Chat and Method 2). Thus, Cook in view of PowWow still meets the scope of the limitation as currently claimed.

See Advisory Action, page 2 (emphasis added). Appellants disagree with the Examiner's characterization of PowWow. The Examiner seems to be asserting that PowWow requires a communication of a text instant message from one user to another in order for voice communications to begin. The Examiner refers to PowWow's Voice Chat instructions and, in particular, to Method 2 of the PowWow Voice Chat instructions in support of this contention.

The PowWow voice chat instructions state that "Voice Chat can be done only from the Personal Communicator window and only when you already have a connection with a person." Method 2 of the voice chat instructions state "Click the Voice button on the window's button bar. (This button is displayed only when two or more people are connected through the personal Communicator window)." Accordingly, PowWow merely states that a connection between two or more people is a necessary condition precedent for the voice button to be displayed. PowWow does not describe or suggest that communication of a text instant message is a necessary condition precedent for display of the voice button, much less for display of the Personal Communicator window. Nor is such a feature inherent in PowWow's system. For example, PowWow's system, being referred to as a chat system, may operate just like a chat system in that users connect to other users by merely entering a chat room rather than by communicating text messages. Accordingly, the voice button in the Personal Communicator window may appear in response to a user connecting in a manner similar to a user entering a chat room, rather than in response to communication of a text instant message from one user to another. If there is at least one other person in the "chat room" when the user enters the "chat room" (i.e., 2 or more people are connected, including the person that just entered the "chat room"), the Voice button is displayed. The user that entered the chat room may then immediately start a voice chat with the other one or more users in the chat room by simply selecting the Voice button without ever having to send a text message to the one or more other users. Accordingly, contrary to the Examiner's contention, nothing in PowWow describes or suggests that the communication of text instant messaging must be present in order for voice communications to commence.

For at least these reasons, appellants request reversal of the rejection of claims 1, 21 and 22, and their dependent claims 2-20, 23-25, 37-39 and 41-43.

(b) The subject matter of independent claim 44 is not obvious in view of the teachings of Cook and PowWow

Independent claim 44 recites, among other features, “receiving, from a sender, a text instant message addressed to a recipient,” “determining, in response to receipt of the text instant message, the capabilities of the recipient to accept voice communications” (emphasis added) and “enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and includes an icon, the presentation of the first text instant messaging graphical user interface being conditioned on whether the recipient is determined to be capable of accepting voice communications” (emphasis added). As stated above, Cook describes an e-mail system that has been modified to support the communication of voice messages. Cook’s e-mail system is not an instant messaging system. In fact, Cook does not mention instant messaging at all and, accordingly, Cook does not describe or suggest the above-recited instant messaging features, including presentation of the recited GUI being conditioned on whether a recipient is determined to be capable of voice communications in response to receipt of a text instant message by the recipient. For at least the reasons described above, PowWow does not rectify the deficiency of Cook with respect to conditioning the presentation of the above-recited GUI. Accordingly, appellants request reversal of the rejection of claim 44.

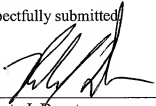
Appellants submit that all of the rejections of the pending claims are improper and request allowance of the pending claims.

The fee in the amount of \$620 in payment for the Appeal Brief fee (\$500) and the Petition for One-Month Extension of Time fee (\$120) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

6/18/07



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Appendix of Claims

1. (Previously Presented) A communications method comprising:
establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host;
facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender;
enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient; and
enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host.
2. (Previously Presented) The method of claim 1 further comprising receiving and authenticating the text instant message from the sender at the instant messaging host.
3. (Previously Presented) The method of claim 2 wherein authenticating the text instant message comprises identifying a screen name associated with at least one of the sender and the recipient.
4. (Previously Presented) The method of claim 2 wherein authenticating the text instant message comprises identifying an IP address associated with at least one of the sender and the recipient.
5. (Previously Presented) The method of claim 1 further comprising determining voice communication capabilities of the recipient at the instant messaging host.
6. (Previously Presented) The method of claim 5 wherein determining voice communication capabilities comprises identifying hardware associated with the recipient.

7. (Previously Presented) The method of claim 5 wherein determining voice communication capabilities comprises identifying software associated with the recipient.

8. (Previously Presented) The method of claim 5 further comprising reporting the voice communication capabilities of the recipient to the sender.

9. (Previously Presented) The method of claim 8 further comprising presenting a second text instant messaging interface to the sender that varies according to the capabilities of the recipient.

10. (Previously Presented) The method of claim 1 further comprising receiving, at the instant messaging host, a request to establish voice communication.

11. (Previously Presented) The method of claim 10 wherein the request is from the sender.

12. (Previously Presented) The method of claim 10 wherein the request is from the recipient.

13. (Previously Presented) The method of claim 10 further comprising authenticating the request.

14. (Previously Presented) The method of claim 11 wherein authenticating the request comprises identifying a screen name associated with at least one of the sender and the recipient.

15. (Previously Presented) The method of claim 11 wherein authenticating the request comprises identifying an IP address associated with at least one of the sender and the recipient.

16. (Previously Presented) The method of claim 1 wherein enabling voice communication comprises establishing a generic signaling interface channel, a control channel, and an audio channel between the sender and the recipient.

17. (Previously Presented) The method of claim 16 further comprising attempting a mode UDP test on the audio channel.

18. (Previously Presented) The method of claim 16 wherein the control channel comprises a TCP/IP socket.

19. (Previously Presented) The method of claim 16 wherein the audio channel comprises a UDP channel.

20. (Previously Presented) The method of claim 16 wherein the audio channel comprises a TCP channel.

21. (Previously Presented) A communications apparatus comprising an instant messaging host configured to:

establish a text instant messaging communication session between a sender and a recipient;

facilitate a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender;

enable presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient; and

enable manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient.

22. (Previously Presented) A computer program, stored on a tangible computer readable medium, comprising instructions for:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host;

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender;

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient; and

enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host.

23. (Previously Presented) The computer program of claim 22 wherein the computer readable medium is a disc.

24. (Previously Presented) The computer program of claim 22 wherein the computer readable medium is a client device.

25. (Previously Presented) The computer program of claim 22 wherein the computer readable medium is a host device.

27. (Withdrawn) A communications method comprising:
enabling a sender to send a text instant message to a recipient;
determining the availability of the sender to participate in voice communication with the recipient; and

enabling the recipient to perceive the availability of the sender to participate in voice communication with the recipient in response to delivery of the text instant message.

28. (Withdrawn) The method of claim 27 wherein determining the availability of the sender to participate in voice communications with the recipient comprises determining the voice communication capabilities of a computer system associated with the sender.

29. (Withdrawn) The method of claim 27 wherein enabling the recipient to perceive the availability of the sender in response to delivery of the instant message comprises enabling the recipient perceive the availability of the sender after delivery of the instant message.

30. (Withdrawn) The method of claim 29 wherein enabling the recipient to perceive the availability of the sender after delivery of the instant message comprises enabling the recipient to perceive the availability of the sender after receipt of the instant message by the recipient.

31. (Withdrawn) The method of claim 27 wherein enabling the recipient to perceive the availability of the sender in response to delivery of the instant message comprises enabling presentation of a text instant messaging interface to the recipient in which the text instant message and the availability of the recipient are displayed to the recipient.

32. (Withdrawn) The method of claim 27 wherein enabling the recipient to perceive the availability of the sender in response to delivery of the instant message comprises enabling the recipient perceive the availability of the sender conditioned on receipt of the instant message.

33. (Withdrawn) The method of claim 27 further comprising enabling the recipient to request initiation of voice communication between the sender and the recipient conditioned on whether the recipient is determined to be available.

34. (Withdrawn) The method of claim 33 wherein enabling the recipient to request initiation of voice communication between the sender and the recipient comprises enabling the recipient to request initiation of voice communications through manipulation of a text instant messaging interface in which the text instant message and the availability of the recipient are displayed to the recipient.

35. (Withdrawn) The method of claim 33 further comprising enabling the recipient to accept the request to initiate voice communication.

36. (Withdrawn) The method of claim 33 further comprising initiating voice communication between the sender and the recipient conditioned on the recipient accepting the request.

37. (Previously Presented) The method of claim 1, wherein enabling manipulation of icon by the recipient to invoke voice communication comprises enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient.

38. (Previously Presented) The apparatus of claim 21, wherein the instant messaging host is configured to enable manipulation of the icon by the recipient to invoke voice communication by enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient.

39. (Previously Presented) The computer program of claim 22, wherein the instructions for enabling manipulation of the icon by the recipient to invoke voice communication include instructions for enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient.

41. (Previously Presented) The communications method of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient.

42. (Previously Presented) The communications apparatus of claim 21, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient.

43. (Previously Presented) The computer system of claim 22, wherein the presentation of the first text instant messaging graphical user interface being conditioned on receipt of the text

instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient.

44. (Previously Presented) A communications method comprising:
receiving, from a sender, a text instant message addressed to a recipient, the text instant message including message text inputted by the sender;
determining, in response to receipt of the text instant message, the capabilities of the recipient to accept voice communications;
delivering the text instant message to the recipient;
enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and includes an icon, the presentation of the first text instant messaging graphical user interface being conditioned on whether the recipient is determined to be capable of accepting voice communications; and
enabling manipulation by the recipient of the icon to invoke voice communications between the sender and the recipient through the instant messaging host.

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Evidence Appendix

None

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Related Proceedings Appendix

None